

REMARKS/ARGUMENTS

The Office Action of December 20, 2006 has been carefully reviewed and this paper is Applicants' response thereto. Claims 1-11, 13-21, 23, 28-29, 32, 37-38 and 43-46 are pending in the application. Claims 12, 22, 24-27, 30-31, 33-36 and 39-42 are cancelled. Claims 1-10, 13-20, 23, 28-29, 37-38 and 43-46 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,128,538 to Fischell *et al.* (Fischell). Claims 11, 21 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fischell. In response, Applicants respectfully traverse the rejections in view of the following remarks.

Rejection under 35 U.S.C. §102(e) – Fischell

Claims 1-10, 13-20, 23, 28-29, 32, 37-38 and 43-46 were rejected under 35 U.S.C. § 102(e) as being anticipated by Fischell. Claims 1, 14, 28, 29, 37, 38, 43 and 45 are independent.

Claim 1 recites the feature “preventing the therapy device from delivering therapy to the patient for a predetermined quantity of block counts after the therapy device has been activated” (emphasis added). The Office Action suggests that Fischell discloses this feature, pointing to the follow section of Fischell:

from the epileptic focus. To improve signal-to-noise ratio, the signal received at a specified location which is at a specific distance from the epileptic focus could have a specific time delay to account for the propagation time it takes for the signal to reach that electrode. For example, if

Fischell, Col. 3, Ln. 17-21. However, the delay discussed in Fischell is referring to the delay in receiving a signal due to the time it takes for a signal to propagate from a starting point to different locations within the patient's brain. Plainly, the propagation delay in receiving a signal as discussed in Fischell is unrelated to the recited feature of claim 1 regarding delay of the delivery of therapy. In addition, Applicants have been unable to locate any other portion of Fischell that actually discloses the feature “preventing the therapy device from delivering therapy...” as recited in claim 1. Therefore, Fischell fails to disclose all the features of claim 1 and cannot be said to anticipate claim 1.

Independent claims 14, 43 and 45 recite a similar feature and, therefore, are not

anticipated for at least the reasons that claim 1 is not anticipated.

Claims 2-11, 13, 15-20, 23, 44 and 46 depend from one of the independent claims 1, 14, 43 and 45 and, therefore, are not anticipated for at least the reasons that the independent claims 1, 14, 43 and 45 are not anticipated and for the additional features recited therein.

Independent claims 28, 29, 37 and 38 recite features similar to the features “determining whether the programming information can result in delivery of therapy with a number of stimulations per detection being above a predetermined stimulations per detection limit” and “preventing the therapy device from being configured according to the programming information if it could result in delivery of a number of stimulations per detection above the predetermined stimulations per detection limit” recited by claim 28. The Office Action has failed to provide any rationale for why these claims can be considered anticipated by Fischell given the admission by the Examiner that Fischell fails to disclose this type of feature. Accordingly, the rejection of these claims cannot be maintained.

In view of the above, withdrawal of this ground of rejection is respectfully requested.

Rejections under 35 U.S.C. §103 - Fischell

Claims 11, 21 and 32 were rejected under 35 USC §103(a) as being obvious over Fischell. Claim 32 is independent.

Looking first at the dependent claims, claim 11 depends from claim 1 and Fischell fails to disclose all the features of claim 1 as discussed above. Similarly, Claim 21 depends from claim 14 and Fischell also fails to disclose all the features of claim 14. Therefore, Fischell fails to disclose all the features of both claims 11 and 14. Consequentially, the Office Action fails to make a *prima facie* case of obviousness with respect to claims 11 and 14.

Regarding claim 32, the Examiner has admitted that Fischell fails to disclose the features recited in steps (d) and (e) of claim 32 but alleges that the general desire to provide a fail-safe makes the recited feature obvious. Applicants first note that this alleged “well known” desire in the art to include such a fail safe is not supported by the Office Action. Therefore, proper support for this proposition is respectfully requested. See MPEP 2144.03 (explaining that it is “never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record”).

Applicants further note that claim 32 does not merely recite “including a fail-safe” or some other generic method step but instead recites the feature “determining whether the programming information can result in stimulation ON time being outside of an acceptable range of between 1 second and 24 hours” and further recites the feature “preventing the therapy device from being configured according to the programming information if it could result in the stimulation ON time being outside of the acceptable range.” Therefore, even if it is assumed (which Applicants do not admit) that there is support in general for the existence a desire to provide some fail-safe feature, this general desire would not make the details of claim 32 obvious. In other words, claim 32 recites a specific set of steps and the mere existence of a desire to provide a fail safe, if supported, would not render the recited features obvious. Here, the Office Action fails to provide sufficient support for the general existence, let alone the details of the features recited in claim 32. Therefore, the Office Action fails to make a *prima facie* case of obviousness with respect to claim 32. Applicants further note that any similar rejection of claims 28, 29, 37 and 38 based on Fischell would also suffer the same deficiencies.

Accordingly, withdrawal of this ground of rejection is respectfully requested.

CONCLUSION

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the number set forth below.

Respectfully submitted,

Dated: March 20, 2007

By: /Stephen L. Sheldon/
Stephen L. Sheldon
Reg. No. 58,732

Banner & Witcoff, Ltd.
10 South Wacker Drive
Suite 3000
Chicago, IL 60606
Tel: (312) 463-5000
Fax: (312) 463-5001